

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Petkovsek EXAMINER: M. Henderson
SERIAL NO.: 09/394,228 GROUP ART UNIT: 3722
FILING DATE: Sept. 13, 1999 ATTY. DKT. NO.: USA-P-99-012
INVENTION: "INTEGRAL SPECIAL SERVICE MAILING ASSEMBLY AND
A METHOD FOR USING THE SAME"

Asst. Commissioner for Patents
Washington, D.C. 20231

APPELLANT'S APPEAL BRIEF

S I R:

This Appeal Brief is submitted in support of the Notice of Appeal filed on September 11, 2001. The Appeal was taken from the Final Rejection.

I. REAL PARTY IN INTEREST

Glenn Petkovsek is the real party in interest as the inventor of this application. No assignment has been filed or recorded in the U.S. Patent Office regarding ownership interest of this application.

II. STATUS OF CLAIMS

Claims 1-23 are pending in this patent application. A copy of the claims is appended hereto as the Appendix. The Final Rejection finally rejects Claims 1-4, 7-9, 11 and 12, finally objects to Claims 5, 6 and 10, and allows Claims 13-

23. A copy of the Final Rejection is appended hereto as Exhibit A of the Supplemental Appendix.

III. STATUS OF AMENDMENTS

All amendments have been entered in this patent application. Appellant's request for reconsideration after Final Rejection was considered by the Examiner. No amendments were made in response to the Final Rejection.

IV. SUMMARY OF THE INVENTION

The present invention provides a form for mailing an article requiring special services. More specifically, the present invention relates to an integral special service mailing assembly for mailing an article requiring special services having a return receipt postcard and a label indicative of the special service and a method for using the same.

As generally illustrated in Figures 7-9, a mailing assembly 100 includes a first layer 102 and a second layer 104. The first layer 102 and the second layer 104 are separably attached via an adhesive 106 between selected portions of the two layers 102,104. The first layer 102 includes a plurality of separable parts including a return postcard 108 having an integrally formed designator section 110. The return postcard conforms with requirements for, for

example, United States Postal Service Form 3811. The designator section 110 includes information necessary to comply with requirements for, for example, United States Postal Service Forms 3804, 3806, 3813, 3856 or the like. (Page 12, line 36 - page 13, line 13).

The return receipt postcard 13 has a number of sub-sections requiring completion by the sender prior to mailing. One sub-section illustrated at numeral 26 includes a machine readable article identification number corresponding to the number in the window section 16 of the pre-printed label 12. The sub-section 26 may have a background color that contrasts with the color of the return receipt postcard 13 so as to simplify the reading of the machine-readable code in the sub-section 26. Other sections, as well, may include similar color-contrasting portions within the return receipt postcard 13. (Page 8, line 34 - Page 9, line 9).

The designator section 110 includes a first area 112 that is distinctly colored from a remainder of the area. For example, the color of the first area 112 may be green to designate the generally recognized color for certified mail or may be brown to designate the generally recognized color for return receipt for merchandise, or the like. Within the first area 112, wording areas 114, 116 may be provided to

specifically denote the type of special service for which the mailing assembly is to be implemented. An article identifying number area 118 is provided within the designator section 110 to provide, preferably, a machine readable number associated with the mailpiece. (Page 13, line 27 - page 14, line 3).

A special instruction area 120 is also incorporated within the designator section 110. Both the article identifying number area 118 and the special instruction area 120 have a distinctly colored background to improve the machine readability of the information within these areas. The special instruction area 120 may include, for example, specific instructions such as "RESTRICTED DELIVERY", "ADDRESSEE'S ADDRESS REQUESTED", "RETURN RECEIPT REQUESTED" or the like. The return postcard 108 includes other information generally required within specific sections, such as sender information area 122, article addressee area 124, recipient name area 126, recipient signature area 128, date received area 130, machine readable document control area 132, and addressee address area 134. (Page 14, line 6 - page 14, line 20).

Various indicia may be printed on the label 310 by any known printing means. However, the indicia including the

special services designator 316 may be printed using only a single color. For example, if the designator 316 refers to certified mail, the certified mail designator 316 may be printed green to indicate the generally recognized color indicative of certified mail. The remaining indicia and any shading to be printed upon the label 310 may also be green. This allows the indicia and the designator 316 to utilize only one color thereby simplifying the printing process requiring a single color print cartridge, ribbon or the like. (Page 18, line 18-29).

V. THE ISSUES ON APPEAL

1. Would Claims 1 and 9 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention in view of U.S. Patent No. 5,664,725 to Walz?

2. Would Claim 7 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention in view of U.S. Patent No. 5,664,725 to Walz?

VI. GROUPING OF CLAIMS

Appellant argues for the patentability of independent Claims 1 and 9 separately and apart from one another. Appellant argues for the patentability of Claim 7 separately

and apart from independent Claim 1 from which it depends. Appellant does not argue for the patentability of Claims 5, 6 and 10 separately and apart from their respective independent claims since the Examiner noted that these claims would be allowed if they were rewritten in independent form including all of the limitations of the base claim and any intervening claims. Appellant does not argue for the patentability of Claims 2-6, 8 and 10-12 separately and apart from their respective independent claims. Appellant notes with appreciation that Claims 13-23 have been indicated as allowable.

VII. ARGUMENTS

The present invention relates to an integral special service mailing assembly for mailing an article requiring special services having a label that includes a return postcard integrally formed with a designator section and a method for using the same. Independent Claim 1 defines a special service mailing assembly comprising a label with a return postcard integrally formed with a designator section indicative of a special service. The designator section is contained completely within the exterior sides that define the return postcard. The label includes shading and printing wherein the shading and printing are a single color.

Independent Claim 9 defines a method for preparing a mailpiece for delivery by a special service. The method requires the steps of providing a label and providing at least one anchor portion. The label has a front side and a back side. The label includes a return postcard integrally formed with a designator section indicative of the special service. The designator is contained completely within exterior sides that define the return postcard. The label also includes shading and printing wherein the shading and printing are a single color. The anchor portion is on an exterior side of the return postcard. The anchor portion has a backside wherein the backside of the anchor portion has an adhesive. The method also requires the steps of removing a backing strip disposed over the adhesive and attaching the label to a mailpiece to effect delivery by the special service.

**A. THE CITED REFERENCE AND REJECTIONS OF CLAIMS 1 AND 9
UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER WALZ**

Claims 1 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,664,725 to Walz. (hereinafter "Walz", a copy of which is attached as Exhibit B of the Supplemental Appendix). The Final Rejection (a copy of which is attached hereto as Exhibit A of the Supplemental

Appendix) states:

Claims 1-3, 7-9 and 11 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over *Walz* (5,664,725). *Walz* discloses in Fig. 1, 4, and 5, a label having a front side (A) and a backside (B) wherein the label (12) includes a postcard (70) and an integrally formed designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5). However, *Walz* does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color. In regards to Claims 9 and 11, the method for preparing a mailpiece for delivery is inherently taught by *Walz*.

(See Final Rejection, page 3, Exhibit A of the Supplemental Appendix.)

**B. CLAIMS 1 AND 9 ARE NOT OBVIOUS UNDER 35 U.S.C. §103(a)
IN VIEW OF WALZ**

With respect to the rejection of Claims 1 and 9 under 35 U.S.C. §103(a) in view of *Walz*, Appellant respectfully submits that the claims distinctly define the present invention from *Walz* for the reasons that follow.

Independent Claim 1 defines a special service mailing assembly having a label. The label has a front side and a backside and includes a return postcard integrally formed with a designator section indicative of a special service. The designator section is contained completely within

exterior sides that define the return postcard. The label further includes shading and printing wherein the shading and printing are a single color.

Independent Claim 9 defines a method for preparing a mailpiece for delivery by a special service. The method requires the steps of providing a label and providing at least one anchor portion. The label has a front side and a back side. The label includes a return postcard integrally formed with a designator section indicative of the special service. The designator is contained completely within exterior sides that define the return postcard. The label also includes shading and printing wherein the shading and printing are a single color. An anchor portion is on an exterior side of the return postcard. The anchor portion has a backside wherein the backside of the anchor portion has an adhesive. The method also requires the steps of removing a backing strip disposed over the adhesive and attaching the label to a mailpiece to effect delivery by the special service.

As set forth by the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend

on the intended use of the assembly and the desired information to be displayed." (See Final Rejection, paragraph 7, attached hereto as Exhibit A of the Supplemental Appendix.) Further, the Examiner contends that "when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability." (See Final Rejection, paragraph 7, attached hereto as Exhibit A of the Supplemental Appendix.)

Contrary to this assertion by the Examiner, the designator section as defined by Claims 1 and 9 is integrally formed with the return postcard wherein the designator section is completely within the exterior sides that define a return postcard. Accordingly, this arrangement of the return postcard with the designator section provides at least two forms on a single sheet. This arrangement allows for the printing of more than one form at a time. For example, a single sheet having two forms may pass through a printer wherein both forms are printed upon such that each form may be used for, for example, two different letters or packages. Accordingly, companies and/or individuals may save time preparing necessary forms that require completion to effect delivery of mailpieces requiring a special service. Further,

companies may save space by not having to stock multiple types of forms for use since the assembly defined by the claims of the present invention provides more than one form may be provided on a single sheet. Thus, the functional relationship of the assembly is altered.

Moreover, nowhere does *Walz* teach a postcard integrally formed with a designator section indicative of a special service, such as, for example, certified mail, return receipt for merchandise, insured mail and registered mail. With regard to the designator section in *Walz*, the Examiner stated that "the 'designator section' (73) is integrally formed with the postcard (previously stated as (70), but it is now disclosed as an area (A), defined between the perforated lines 24 and 26, as stated in Col. 4, lines 40-53) and is contained within the exterior sides (24a and 26a)." In fact, the Examiner admits in the Final Rejection that *Walz* does not disclose a designator section indicative of a special service and having a machine readable code. (See Final Rejection, page 3.)

Appellant submits that the designator section in *Walz* is not used to indicate a special service; rather, the designator section is used for "an area 70 for receiving the address to which the item is to be mailed, as well as areas

71, 72 for receiving signatures of the addressee and agent, area 73 for indicating other services requested such as addressee's address and restricted delivery, area 66 carrying the article number in OCR-A font and a corresponding barcoded article number 75, area 76 for entering the date of delivery, and area 77 for entering a new address if the addressee has moved and this service has been requested and paid for." (See *Walz*, Col. 4, lines 43-52, attached as Exhibit B in the Supplemental Appendix.) Nowhere does *Walz* teach a designator section used to indicate a special service as required in Claims 1 and 9 of the present invention.

The Examiner provided no teaching as to why one having ordinary skill in the art would have been led to modify the form disclosed by *Walz* that was applied in the Office Action in the rejection under 35 U.S.C. §103(a) and to modify that label to provide a designator section indicative of a special service. Further, the Examiner provided no teaching of a label that includes printing and shading wherein the printing and shading are a single color.

In the Final Rejection, the Examiner asserts that the method for preparing a mailpiece for delivery is inherently taught by *Walz* and the choice of ornamentation (color or shading) produces no mechanical effect or advantage. In

fact, the Examiner admits that *Walz* does not teach printing wherein the shading and printing are a single color. (See Final Rejection, page 3.)

Appellant asserts that *Walz* merely discloses a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. One of the separable sections includes a return postcard. Absolutely no teaching exists in *Walz* to shade and print the label with a single color.

As defined in Claims 1 and 9, the label of the present invention requires shading and printing wherein the shading and printing are a single color. For example, the shading may be green to designate the generally recognized color for certified mail, or the shading may be brown to designate the generally recognized color for return receipt for merchandise mail, or the like, as stated in the specification at page 13, lines 29-34 and defined by Claims 1 and 9. In addition, if the shading is green, the information printed on the label is also green; likewise, if the shading is brown, the information printed on the label is also brown, i.e. "the shading AND printing are a single color" (emphasis added.)

By providing shading and printing of a single color to the labels to designate a special service, the present invention advantageously simplifies and expedites the preparation of a mailpiece by requiring a single print cartridge, ribbon or the like as stated in the specification at page 18, lines 28-29.

On the contrary, the ornamentation of the form disclosed by *Walz* requires multiple colors. *Walz* merely teaches a label that shades in one color and prints in another color. As a result, multiple passes and/or multiple cartridges or ribbons are required to complete the form of *Walz*. Thus, the mailing assembly as defined by the claims of the present invention is distinct from *Walz*.

It is further submitted that the question under 35 U.S.C. §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements performed their ordained and expected functions. The test is whether the invention as a whole, in

light of the teaching of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F. 2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Examiner, the resultant assembly and method and still lacks the critical steps and structural relationships positively recited in the claims.

With the deficiencies of *Walz* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Walz* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Examiner as required under 35 U.S.C. §103.

Accordingly, Claims 1 and 9 are not obvious in view of *Walz*, and the rejection under 35 U.S.C. §103(a) in view of

Walz should be withdrawn. Notice to that effect is requested.

**C. THE CITED REFERENCES AND REJECTION OF CLAIM 7 UNDER
35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER WALZ**

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,664,725 to Walz.

The Final Rejection states:

In regards to Claim 1, 7, 9 and 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

(See Final Rejection, page 3-4, Exhibit A of the Supplemental Appendix.)

**D. CLAIM 7 IS NOT OBVIOUS UNDER 35 U.S.C. §103(a)
IN VIEW OF WALZ**

With respect to the rejection of Claim 7 under 35 U.S.C. §103(a) in view of Walz, Appellant respectfully submits that the claim distinctly defines the present invention from Walz for the reasons that follow.

Dependent Claim 7 defines the assembly of Claim 1

further comprising an area within the designator section that has a machine readable code.

Nowhere does *Walz* teach a designator section that has a machine readable code. According to Examiner Henderson, "*Walz* does not disclose: a designator section indicative of a special service and has a machine readable code...". (See Final Rejection, Page 3.)

By providing a designator section that has a machine readable code, the designator section contains information needed to, for example, track the mailpiece.

It is further submitted that the question under 35 U.S.C. §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements performed their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v.*

Sears, Roebuck & Co., 722 F. 2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have modified *Walz* as applied by the Examiner, the resultant assembly still lacks the structural relationships positively recited in the claims.

With the analysis of the deficiencies of *Walz* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Walz* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Examiner as required under 35 U.S.C. §103.

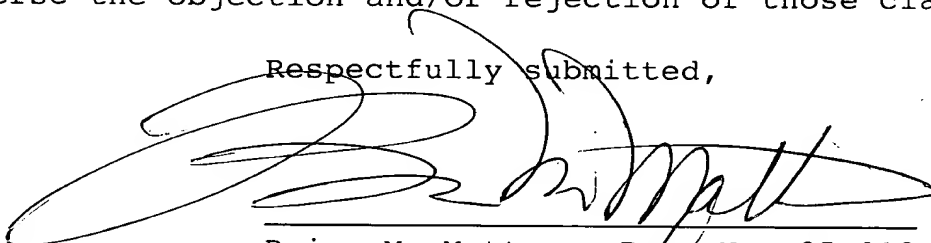
Accordingly, Claim 7 is patentably distinct from *Walz*, and the rejection under 35 U.S.C. §103(a) in view of *Walz* should be withdrawn. Notice to that effect is requested.

VIII. CONCLUSION

For the foregoing reasons, Appellant respectfully

submits that the rejections of Claims 1, 7 and 9 are erroneous as a matter of law and fact, and respectfully requests the Board to reverse the rejection. Moreover, since the rejection of the above-identified claims is erroneous, Appellant respectfully submits that the objection and rejection of Claims 2-8 and 10-12 is also erroneous as a matter of law and fact, and respectfully requests the Board to reverse the objection and/or rejection of those claims.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Brian M. Mattson', is written over the signature line.

Brian M. Mattson, Reg. No. 35,018
Patents+TMS
1914 North Milwaukee Avenue
Chicago, IL 60647
Tel: 773/772-6009
Attorney for Appellant

TABLE OF CONTENTS

I. APPENDIX: Claims 1-23

II. SUPPLEMENTAL APPENDIX

EXHIBIT A: Final Rejection dated June 6, 2001

EXHIBIT B: U.S. Patent No. 5,664,725 to Walz

APPENDIX

Claims 1-23

1. A special service mailing assembly comprising:
a label having a front side and a backside wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color.
2. The assembly of Claim 1 further comprising:
a first anchor portion associated with the label removably attached to the return postcard wherein the first anchor portion has an adhesive on a backside of the first anchor portion.
3. The assembly of Claim 2 further comprising:
a backing strip disposed over the adhesive on the backside of the first anchor portion.
4. The assembly of Claim 1 further comprising:
a printer track strip associated with the label extending outside one of the exterior sides of the return postcard wherein the printer track strip includes a hole.
5. The assembly of Claim 1 wherein the assembly has a hole disposed therein.
6. The assembly of Claim 1 wherein the label has a width defined between a first end and a second end wherein the first end includes holes disposed therein.
7. The assembly of Claim 1 further comprising:
an area within the designator section that has a machine readable code.

8. The assembly of Claim 1 further comprising:

a second anchor portion attached to the return postcard wherein the second anchor portion has an adhesive on a backside of the anchor portion.

9. A method for preparing a mailpiece for delivery by a special service, the method comprising the steps of:

providing a label having a front side and a back side wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color;

providing at least one anchor portion on an exterior side of the return postcard wherein the anchor portion has a backside and further wherein the backside of the anchor portion includes an adhesive;

removing a backing strip disposed over the adhesive; and

attaching the label to a mailpiece to effect delivery by a special service.

10. The method of Claim 9 further comprising the step of:

providing a hole in the label.

11. The method of Claim 9 further comprising the steps of:

printing information on the return postcard relating to delivery of the mailpiece by a special service.

12. The method of Claim 9 further comprising the step of:

providing a printer tracking strip removably attached to the anchor portion.

13. A special service mailing assembly comprising:

a plurality of labels removably attached continuously

wherein each label has a front side and a back side and further wherein the label includes a return postcard and a designator section indicative of a special service wherein the designator is contained within the exterior sides that define the return postcard; and

a printer track strip associated with each label wherein the printer tracking strip includes a first hole and further wherein each label has a second hole.

14. The assembly of Claim 13 further comprising:

a first anchor portion removably associated with each label removably attached to each return postcard wherein the first anchor portion has an adhesive on a backside of the first anchor portion.

15. The assembly of Claim 14 further comprising:

a strip disposed over the adhesive on the backside of the first anchor portion.

16. The assembly of Claim 13 wherein the second hole on each label is capable of being sensed by a printer.

17. The assembly of Claim 13 further comprising:

an area within each designator section that has a machine readable code.

18. The assembly of Claim 13 further comprising:

a second anchor portion associated with each label wherein the second anchor portion has an adhesive on a backside of the anchor portion.

19. The assembly of Claim 13 further comprising:

a tear line disposed between each label to aid in the removal of each label from the assembly.

20. The assembly of Claim 13 further wherein the second hole is adjacent the tracking strip.

21. A special service mailing assembly comprising:

a label having a front side and a backside wherein the label includes a return postcard and a designator section indicative of a special service wherein the designator is contained within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color and further wherein the assembly has a hole disposed therein.

22. A special service mailing assembly comprising:

a label having a front side and a backside wherein the label includes a return postcard and a designator section indicative of a special service wherein the designator is contained within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color and further wherein the label has a width defined between a first end and a second end wherein the first end includes holes disposed therein.

23. A method for preparing a mailpiece for delivery by a special service, the method comprising the steps of:

providing a label having a front side and a back side wherein the label includes a return postcard and a designator section indicative of a special service wherein the designator is contained within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color;

providing at least one anchor portion on an exterior side of the return postcard wherein the anchor portion has a backside and further wherein the backside of the anchor

portion includes an adhesive;

removing a backing strip disposed over the adhesive;

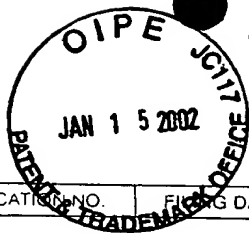
attaching the label to a mailpiece to effect delivery by
a special service; and

providing a hole in the label.

SUPPLEMENTAL APPENDIX

EXHIBIT A: Final Rejection dated June 6, 2001

EXHIBIT B: U.S. Patent No. 5,664,725 to Walz



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

1304.228

09/13/99

PETKOVSEK

G

P-99-012

QM32/0604

EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

06/04/01

JOHN H. MATTSON
GENERAL MANAGER
NATIONAL CORPORATION
1000 MILWAUKEE AVENUE
MILWAUKEE, WI 53233

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

EXHIBIT A

Office Action Summary

Application No.

09/394,228

Applicant(s)

Glenn Petkovsek

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-23 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 11, and 12 is/are rejected.
- 7) ☒ Claim(s) 5, 6, and 10 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Apr 2, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

I The drawings have been amended to overcome the previous objections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3722

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7-9 and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725).

Walz discloses in Fig. 1, 4 and 5, a label having a front side (A) and a backside (B) wherein the label (12) includes a postcard (70) and an integrally formed designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5).

However, Walz does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color.

In regards to Claims 9 and 11, the method for preparing a mailpiece for delivery is inherently taught by Walz.

In regards to Claim 1, 7, 9 and 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the

Art Unit: 3722

present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Also in regards to **Claim 1 and 9**, matters related to the choice of ornamentation (color and shading) producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to integrally form the designator portion with the postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

3. Claims 4 and 12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walz in view of Pekovsek (5,697,648).

Walz discloses in Fig. 1, 4 and 5, a mailing assembly comprising all the elements as set forth in claims 1 and 9, and as set forth above. Walz also discloses an associated backing sheet (14) attached to the backing strips (49) and the postcard (70).

However, Walz does not disclose a printer track strip associated (Webster Dictionary defines as "combined") extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor portion.

Art Unit: 3722

Petkovsek discloses in Fig. 5, a mailing assembly having a backing sheet (11) with a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) and is removably attached to the anchor portion (28)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's mailing assembly by replacing the backing strip associated with the assembly with a backing strip containing a printer track strip as taught by Petkovsek for the purpose of allowing the mailing assembly to be passed through a printer.

Note, the examiner also submits that the patent reference (Petkovsek) is considered prior art because it had issued more than one year prior to the actual filing date (9/13/99) of the application and application claims 4 and 12 recite subject matter not supported by the parent patent (Petkovsek). Therefore, the claims are not entitled to a date earlier than the actual filing date of this application. See MPEP 2133.01.

Allowable Subject Matter

4. Claims 5, 6 and 10 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3722

5. Claims 13-23 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly suggests a mailing assembly comprising a plurality of labels removably attached and includes a postcard, a designator section, and a printer track strip associated with each label wherein the printer tracking strip includes a first hole and each label has a second hole.

Response to Arguments

7 Applicant's arguments filed on April 2, 2001 have been fully considered but they are not persuasive.

In response to applicant's argument that the Petkovsek and Walz references do not disclose a designator section within the exterior sides that define a postcard wherein the designator section is integrally formed with the return postcard, the examiner submits that both Petkovsek and Walz discloses a designator section in Fig. 1 as set forth in the above 103 rejections.

Art Unit: 3722

Conclusion

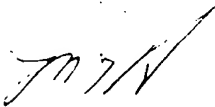
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3722

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 1, 2001

HENRY TSAI
PRIMARY EXAMINER